

Appl. No. 09/787,562
Amdt. dated June 19, 2003
Reply to Office Action of February 19, 2003

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 09/787,562
Applicant : BINLEY et al.
Filed : JULY 6, 2001
Title : POLYNUCLEOTIDE CONSTRUCTS AND USES THEREOF
TC/A.U. : 1632
Examiner : CHEN, SHIN LIN

Docket No. : 9192.16USWO

CERTIFICATE UNDER 37 CFR 1.6(d):

I hereby certify that this correspondence is being transmitted via facsimile to the Commissioner for Patents, TC1600 on June 19, 2003.


By: Michele Quaranto

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT

Dear Sir:

Responsive to the eight-way restriction requirement mailed February 19, 2003, Applicants submit the following election with traverse. Reconsideration of the restricted claim groupings is respectfully requested.

Election:

To the extent the Restricted Groups are maintained and not rescinded for the reasons discussed below, Applicants elect Group I, claims 1-10, 12-15, 20 and 31 drawn to a polynucleotide comprising at least two hypoxia response elements (HRE) having SEQ ID No. 1, 2, or 9, wherein the hypoxia-inducible factor (HIF) consensus binding sites within each of the two repeats are separated by a spacer having SEQ ID No. 10 or 11, and a nucleic acid of interest (NOI) encoding HIF-1, and to vectors and host cells comprising the polynucleotide.

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Upon election of Group I, the Examiner required election of an HRE promoter construct from the group consisting of SEQ ID Nos. 1, 2, and 9. Applicants elect SEQ ID No. 9, which encompasses HRE sequence 2 and spacer sequence 10.

Improper Restriction:

Applicants' respectfully assert the Restriction Requirement imposed on Applicants' claims is improper, and should be rescinded. First, the Examiner's restriction groups based on HRE sequences do not make sense. Restriction Group I (reciting SEQ ID NOs: 1, 2, or 9) includes both HRE sequences 1 and 2 and the HRE-promoter linked construct sequence 9 that contains HRE sequence 2. Group II (reciting SEQ ID NOs 3, 4, and 5) includes the promoter-linked HRE sequences 3 and 4, as well as the reverse construct sequence 5, each containing HRE sequence 2. SEQ ID Nos. 3 and 9 are nucleotide sequences encoding multiple HREs operably linked to a promoter whereas SEQ ID Nos. 1 and 2 are nucleotide sequences encoding HREs. SEQ ID Nos. 1 and 2 encode the HREs in the promoter construct encoded, for example, by SEQ ID Nos. 3 and 9.

Second, the Restriction Groups (I-VIII) each require election of a specific NOI, an optional embodiment of the invention. An alternative NOI, or no NOI is not a choice in the election requirement.

Accordingly, the issued Restriction Requirement is improper in that it fails to consider the core concepts of the invention and fails to appreciate the relationships of the genus claim and dependent species claims. Applicants respectfully request the Restriction Requirement be rescinded, and the restriction be reconsidered, for example, to include at least one Group containing a polynucleotide sequence encoding multiple HREs and optionally, a NOI (any NOI). Reconsideration of the claims on the merits is requested.

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The Examiner is invited to telephone the undersigned attorney for clarification of the election or remarks, or to otherwise speed prosecution of this case.

Respectfully submitted,

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Date: June 19, 2003

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